

REMARKS

Pursuant to 37 C.F.R. 1.98(b), the applicant filed an information disclosure statement for references cited in the patent application. The information disclosure statement was filed electronically on September 16, 2004. The Code of Federal Regulations pertaining to patents and the MPEP do not prohibit an applicant from citing references to U.S. Patents inside the specification so long as an information disclosure statement is also filed in compliance with 37 C.F.R. 1.98(b).

Claim 2 has been amended to provide antecedent basis for "the mouth receiving outlet" in lines 11 and 12 of the claim. Claim 3 has been amended to provide antecedent basis for "said inhaler body portion" in line 5 of the claim.

The Examiner's office action rejection of claims 1, 2, and 4 through 6 under 35 U.S.C. § 103(a), as being unpatentable over Hanson, U.S. Patent No. 6,557,737, is respectfully traversed. In In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992), the Federal Circuit Court of Appeals stated that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." Moreover, on page 3 of the Office Action, the Examiner states that "it would have been an obvious matter of design consideration to use an adhesive disposed on the encasement body as one means [sic] for another inasmuch as adhesive means are well known in the art of attaching purposes, also it is well known to use a protective sheet covering in order to protect the adhesive until time of use." On page 4, the Examiner states that "[o]ne of ordinary skill in the art, furthermore would have expected Applicant's invention to perform equally well with any clip means, as

such clips as alligator and or D shaped clips, are well known in the art for attaching purposes of one item to another.” Clearly, by this language, the Examiner is attempting to apply the “obvious to try” test to Applicant’s invention in determining whether said invention is obvious under 35 U.S.C. § 103(a).

Regarding the “obvious to try” test, the Court of Customs and Patent Appeals has previously stated:

[A]pplication of the “obvious to try” test would often deny patent protection to inventions growing out of well-planned research which is, of course, guided into those areas in which success is deemed most likely. These are, perhaps, the obvious areas to try. But resulting inventions are not necessarily obvious. Serendipity is not a prerequisite to patentability. Our view is that “obvious to try” is not a sufficiently discriminatory test.

In re Lindell, 385 F.2d 453 (C.C.P.A. 1967). Therefore, the Examiner’s assertion that the Applicant’s invention is obvious due to the Examiner’s own belief, in hindsight, that Applicant’s use of the adhesive and spring-loaded clip with jaws was obvious to try does not set forth a sufficiently discriminatory test upon which the Examiner may rely to reject the Applicant’s claims under 35 U.S.C. § 103(a). The Examiner may not use as an element of the obvious rejection that one of ordinary skill in the art would have arrived at the invention by trying different alternative structures or materials, such as the adhesive used in the present invention. Thus, the Examiner’s rejection of claims 1, 2, and 4 through 6 under 35 U.S.C. § 103(a) cannot be sustained.

The Examiner’s office action rejection of claim 3 under 35 U.S.C. § 103(a), as being unpatentable over Hermanson, U.S. Patent No. 5,730,118, is respectfully traversed. The Examiner states that “Hermanson discloses a clip (22) but does not disclose a spring-loaded clip with jaws.” A thorough review of the ‘118 patent reveals that a clip is not

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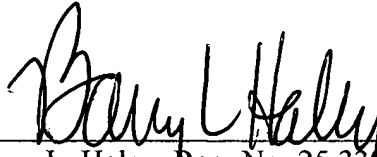
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disclosed anywhere within the '118 patent. In addition, the '118 patent discloses a necklace as the means for allowing the user of the inhaler to wear the inhaler device, while the Applicant's invention describes a spring-loaded clip with jaws used to attach an inhaler device to a user's garment. Thus, the Examiner's rejection of claim 3 under 35 U.S.C. § 103(a) cannot be sustained.

If there are any additional charges, including extension of time, please bill our Deposit Account No. 13-1130.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Barry L. Haley", is written over a horizontal line.

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